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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/893,223 | 06/27/2001 | Shane M. Kelton | 163.1062USD1 | 5643 |
| 7590 12/18/2003 | | | EXAMINER | |
| DAVID R. CLEVELAND IPLM GROUP, P.A. POST OFFICE BOX 18455 MINNEAPOLIS, MN 55418 | | | DICUS, TAMRA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1774 | |

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,223

Applicant(s)

KELTON ET AL.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-42 and 45-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-42 and 45-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The cancellation of claim 36 is acknowledged. The 102(b) rejections over Morrison and Owens are withdrawn due to Applicant's amendments. The 103(a) rejection to Saylor is withdrawn due to Applicant's amendments.

Claim Objections

2. The amendment filed 11-03-03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the specification does not provide any teaching or discussion in how an underlying core is used in conjunction with a floor traffic surface, or structured as an underlying core adjacent to the flooring surface, or how to make the underlying core or multilayered structure. Figure 6 is newly presented as containing Reference No. 78, but is not provided for. #78 is not described in the specification as to what this is or is made of. Essentially, the original specification is absent to any teaching of how a flooring surface and underlying core are laminated together, if that is Applicant's intent for the additional new modifications.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 45-47 and 38-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It appears the Applicant is newly presenting a new structured tile, comprising a flooring surface and underlying core. While the Applicant includes a description of a core, independent claim 45 (new) does not have the proper support in the original specification as filed because the specification does not provide any teaching or discussion in how an underlying core is used in conjunction with a floor traffic surface, or structured as an underlying core adjacent to the flooring surface, or how to make the underlying core or multilayered structure. Figure 6 is newly presented as containing Reference No. 78, but is not provided for. #78 is not described in the specification as to what this is or is made of. Essentially, the original specification is absent to any teaching of how a flooring surface and underlying core are laminated together, if that is Applicant's intent for the additional new modifications.

Drawings

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Reference No. 78 is not in the specification. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 38-42 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,314,554 to Owens.

Owens teaches a method of producing a laminated tile, where quarry tile is suitable for use and the tile composition is of 60-75% by weight silica and 15-25 % by weight alumina at col. 7, lines 1-40. The tile of Owens functions as a traffic flooring because it is of the same material. The coefficient of friction is an inherent property of the tile itself. Because the tile of Owens is made of the components as Applicant claims, the claimed features would therefore be inherent. Further, the tile is not a different product because it is wet or dry, clean or soiled. While Applicant refers to a new microscopic peak and valley, to which Owens does not state *per se*, such variation is naturally inherent to quarry tiles. Per Applicant's own admission, the quarry tile naturally has microscopic peaks at pg. 3, lines 5-6. Further Owens teaches microscopic pores and crevices on the upper surface at col. 8, lines 1-2 and also at col. 10, providing protrusions and reservoirs. Owens further provides an underlying core, 4 in Figure 2 of various types of quarry tile compositions at col. 7, lines 10-45 and of ceramic. The tile configuration and structure includes an underlying region of the same material-quarry, which is on an upper region/surface also. Additionally, there are subsequent layers, more than one, which may be

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applied to the substrate of natural stone material; thereby providing a laminate structure. While Owens does not state in the same words, e.g. a same material used in the underlying core and upper layers, the upper layers are still of the same material, because the entire tile material is made of quarry, which includes an underlying region of quarry and an upper surface of quarry elemental composition. It would have been obvious to one of ordinary skill in the art to modify to include the underlying core as a separate layer of the same material as a surface layer because extra layers like stone and marble are multilayers that are laminated see col. 4, lines 20-30. It would have been obvious to one of ordinary skill in the art to modify an underlying core and upper layer of similar material because Owens provides additional layers of similar composition may be laminated to provide a multilayered tile structure.

Response to Arguments

Applicant asserts all cited references do not have an underlying core the same compositional make-up of the upper layer. As previously said, Applicant has not provided any underlying core. Further Owens is still used to provide this teaching as explained above.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 5,902,411 to Williams et al. teaches a treatment including microscopic and macroscopic surface variations effect the coefficient of friction for traffic tiles including quarry types and ceramic. Example 5 explains the COF from 0.7 to 0.9 for a slip-resistant surface.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tamra L. Dicus
Examiner
Art Unit 1774

December 15, 2003

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Cynthia Kelly